



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,248	03/08/2001	Thomas E. Chefalas	YOR920000718US1 (14031)	5564
7590	04/12/2005		EXAMINER	
Richard L. Catania Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530			NELSON, FREDA ANN	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,248

Applicant(s)

CHEFALAS ET AL.

Examiner

Freda Nelson

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,10-14,16-19 and 22-35 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 and 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5,10-11,19 and 22-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This is in response to a communication filed December 6, 2004. The applicant has amended claims 1, 3-5, 10-14, 16-19, and 22-31. Claims 2, 6-9, 15, and 20-21 have been canceled. Claims 32-35 have been added. Claims 1, 3-5, 10-14, 16-19, and 22-31 are pending.

Response to Amendment and Argument

Applicant's arguments with respect to claims 1, 3-5, 10-14, 16-19, and 22-31 have been considered but are moot in view of the new ground(s) of rejection.

Election/Restrictions

Newly submitted amended claims 12-14 and 16-18 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 1, 3-5, 10-11, 19, 22-35, drawn to a computer-implemented method for automating product registration, classified in class 705, subclass 1; and

Claims 12-14 and 16-18, drawn to an automated telephonic method for product registration, classified in class 705, subclass 26.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 12-14 and 16-18 are withdrawn from

consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 10, 19, 22, 24-25, 27-28, 31, 33, and 35 is rejected under 35 U.S.C. 102(b) as being anticipated by Flickinger et al. (US PG Pub. 2001/0025245).

In claims 1 and 10, Flickinger et al. discloses a method for electronic registration of assets in a registration database, using E-registrar which can be applied for both to online purchases and to conventional purchases (paragraph 0019). Flickinger et al. further discloses an example in which an asset created by a manufacturer (122) is purchased from the seller (120) using a credit card and the third party credit card company (140) provides the asset registration database (130) (paragraph 0028; FIG. 3). Flickinger et al. further disclose that during or at the conclusion of a transaction to purchase an asset, the seller (120) prompts the purchaser (110) to register the asset being purchased (paragraph 0023). Flickinger et al. still further disclose that the purchaser-specific data file, called an E-registrar, can be an electronic file on a storage media that is accessible to a purchaser's computer (e.g., integrated into the OS or web browser, smart card reader), or could be maintained by a third party (e.g., credit card company website where purchaser creates and updates his E-registrar file via the Internet); and the data on this electronic file can be extracted during the purchasing transaction (e.g., point-of-sale (POS), online) or can be extracted in a separate

transaction initiated by the purchaser after the purchasing transaction (paragraph 0021).

In claim 3 and 22, Flickinger et al. discloses that a method for automatically registering an asset as part of a purchasing transaction for that asset (paragraph 0008).

In claim 4, Flickinger et al. disclose that an example of how the E-registrar is provided to the vendor manufacturer is by a 'drag and drop' E-registrar icon, or alternatively as a file or other unit which can be sent across the network to the manufacturer and the purchaser would send his personal E-registrar via his web browser or email, which would contain standard information needed for registering the asset, to the manufacturer (paragraph 0036).

In claim 5, Flickinger et al. disclose that the electronic file contains data specific to the purchasing entity, including such information as would typically be requested for registration of an asset (e.g., name, address, and marketing information) wherein the data in the E-registrar is extracted by the purchasing transaction application, the credit approval application, or another application activated by one of the parties to the transaction (paragraph 0009).

In claims 19 and 27-28, Flickinger et al. discloses a method for electronic registration of assets in a registration database, using E-registrar which can be applied for both to online purchases and to conventional purchases (paragraph 0019).

Flickinger et al. further discloses an example in which an asset created by a manufacturer (122) is purchased from the seller (120) using a credit card and the third

party credit card company (140) provides the asset registration database (130) (paragraph 0028; FIG. 3). Flickinger et al. further disclose that during or at the conclusion of a transaction to purchase an asset, the seller (120) prompts the purchaser (110) to register the asset being purchased (paragraph 0023). Flickinger et al. still further disclose that the purchaser-specific data file, called an E-registrar, can be an electronic file on a storage media that is accessible to a purchaser's computer (e.g., integrated into the OS or web browser, smart card reader), or could be maintained by a third party (e.g., credit card company website where purchaser creates and updates his E-registrar file via the Internet); and the data on this electronic file can be extracted during the purchasing transaction (e.g., point-of-sale (POS), online) or can be extracted in a separate transaction initiated by the purchaser after the purchasing transaction (paragraph 0021).

In claims 23 and 34, Flickinger et al. disclose that the electronic file contains data specific to the purchasing entity, including such information as would typically be requested for registration of an asset (e.g., name, address, and marketing information (paragraph 0009) . Flickinger further disclose that the purchaser-specific data file, called an E-registrar, can be an electronic file on a storage media that is accessible to a purchaser's computer (e.g., integrated into the OS or web browser, smart card reader), or could be maintained by a third party (e.g., credit card company website where purchaser creates and updates his E-registrar file via the Internet); and the data on this electronic file can be extracted during the purchasing transaction (e.g., point-of-sale (POS), online) or can be extracted in a separate transaction initiated by the

purchaser after the purchasing transaction (paragraph 0021). Flickinger does not disclose that utilizing a telephone number to retrieve customer information, however, it is old and well-known in the business art that telephone numbers are used to retrieve customer information. It is old and well-known that grocery stores and department stores use customer telephone numbers in lieu of smart cards to retrieve customer information in order to give customers discounts. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Flickinger to include the feature telephone number feature as another means to retrieve customer information.

In claims 24 and 35, Flickinger et al. disclose that in the case of some assets which are purchased at a retail outlet or on-line, the purchaser is asked to register the asset on-line via an Internet connection and in either case, the user must perform the product or warranty registration manually (i.e., fill out the card by hand and mail it or log onto the Internet and enter the requested information).

In claim 25, Flickinger et al. disclose that the purchaser would send his personal E-registrar via his web browser or email, which would contain standard information needed for registering the asset, to the manufacturer wherein the manufacturer would extract the pertinent information from the E-Registrar and register the product, and the registration process would be accomplished. The manufacture would provide verification of registration and other information (e.g. warranties) either on the spot through the browser or email, or subsequently through other means, such as mail or facsimile (paragraph 0036).

In claim 31, Flickinger et al. discloses a method for electronic registration of assets in a registration database, using E-registrar which can be applied for both to online purchases and to conventional purchases (paragraph 0019). Flickinger et al. further discloses an example in which an asset created by a manufacturer (122) is purchased from the seller (120) using a credit card and the third party credit card company (140) provides the asset registration database (130) (paragraph 0028; FIG. 3). Flickinger et al. further disclose that during or at the conclusion of a transaction to purchase an asset, the seller (120) prompts the purchaser (110) to register the asset being purchased (paragraph 0023). Flickinger et al. still further disclose that the purchaser-specific data file, called an E-registrar, can be an electronic file on a storage media that is accessible to a purchaser's computer (e.g., integrated into the OS or web browser, smart card reader), or could be maintained by a third party (e.g., credit card company website where purchaser creates and updates his E-registrar file via the Internet); and the data on this electronic file can be extracted during the purchasing transaction (e.g., point-of-sale (POS), online) or can be extracted in a separate transaction initiated by the purchaser after the purchasing transaction (paragraph 0021).

In claim 33, Flickinger et al. discloses a method for electronic registration of assets in a registration database, using E-registrar which can be applied for both to online purchases and to conventional purchases (paragraph 0019). Flickinger et al. further discloses an example in which an asset created by a manufacturer (122) is purchased from the seller (120) using a credit card and the third party credit card

Art Unit: 3629

company (140) provides the asset registration database (130) (paragraph 0028; FIG. 3). Flickinger et al. further disclose that during or at the conclusion of a transaction to purchase an asset, the seller (120) prompts the purchaser (110) to register the asset being purchased (paragraph 0023). Flickinger et al. still further disclose that the purchaser-specific data file, called an E-registrar, can be an electronic file on a storage media that is accessible to a purchaser's computer (e.g., integrated into the OS or web browser, smart card reader), or could be maintained by a third party (e.g., credit card company website where purchaser creates and updates his E-registrar file via the Internet); and the data on this electronic file can be extracted during the purchasing transaction (e.g., point-of-sale (POS), online) or can be extracted in a separate transaction initiated by the purchaser after the purchasing transaction (paragraph 0021).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 29-30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flickinger et al. in view of Dovolis (US PG Pub. 2001/0034609).

In claims 11,29-30 and 32, Flickinger does not disclose that at least one web page allows said customer to indicate that the product is a gift to a donee. Dovolis discloses a simple and effective method for registering warranty information at the point of purchase (paragraph 0013). Dovolis further discloses that the system monitors the duration of the warranty period for each product so that a consumer may later visit the site to see when their warranty expires, to transfer warranties from one person to another if the product is given as a gift, and to view product instructions and other information available online for that particular product (paragraph 0013). Dovolis still further disclose that the system provides a means for consumers to view their purchases on a consumer web page and to personalize their consumer page so as to categorize their products in any way that makes sense to them (paragraph 0013). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Flickinger et al. to include the feature of Dovolis in order to allow warranties to be transferred to from one person to another as is done with automobiles and homes.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flickinger et al. in view of Byrd et al. (Patent Number 6,069,941).

In claim 26, Flickinger et al. does not disclose that the server associated with the manufacturer comprises a voice response unit server. Byrd et al. disclose that as part of the prompt to the subscriber 12, the active one of the VRUs 24 and 25 or the PC server 26 also provides an option to allow the subscriber to register the product (col. 6,

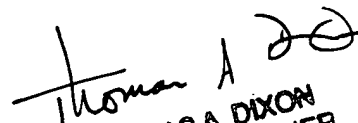
Art Unit: 3629

lines 25-27): Byrd et al. further disclose that the information entered by the subscriber 12 in connection with product registration is typically stored in a transcription VRU 46 within the call platform 20 having the capability of recording the subscriber-entered registration information; and the registration information stored in the transcription VRU 46 may be accessed by a customer transcriber 50 (i.e., a computer maintained by the product manufacturer) that communicates with the call platform 20 by calling a pre-assigned POTS routed to the switch 16 (col.6, lines 35-46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Flickinger et al. to include the feature of Byrd et al. in order to allow consumers to an alternative option to contact the manufacturer's server.

Art Unit: 3629

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


THOMAS A. DIXON
PRIMARY EXAMINER

FAN 04/01/2005